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IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

MEMRY CORPORATION,

No. C-04-03843 RMW

Plaintiff,

v.

KENTUCKY OIL TECHNOLOGY, N.V.,  
PETER BESSELINK, MEMORY METALS  
HOLLAND, B.V.,

ORDER DENYING KENTUCKY OIL'S  
MOTION FOR LEAVE TO FILE MOTION  
FOR RECONSIDERATION

[Re Docket No. 640]

Defendants.

KENTUCKY OIL TECHNOLOGY, N.V.,

Counterclaimant,

v.

MEMRY CORPORATION and  
SCHLUMBERGER TECHNOLOGY  
CORPORATION,

Counterdefendants.

By its order dated April 8, 2005, the court dismissed KOT's sixth counterclaim for declaration of invalidity and unenforceability of STC's issued patents that are allegedly based upon Peter Besselink's Biflex technology. *See Order Granting in Part and Denying In Part*

ORDER DENYING KENTUCKY OIL'S MOTION FOR LEAVE TO FILE MOTION FOR RECONSIDERATION—No. C-04-03843  
RMW  
MAG

1 Counterdefendants' Motion to Dismiss dated April 8, 2005, Docket No. 65. KOT seeks leave of this  
 2 court to file a motion for reconsideration of the court's decision based upon the Supreme Court's  
 3 opinion in *MedImmune, Inc. v. Genentech, Inc.*, 127 S. Ct. 764 (2007).

4 In *MedImmune*, the Supreme Court clarified that the "actual controversy" requirement of the  
 5 Declaratory Judgment Act demands only "that the dispute be definite and concrete, touching the  
 6 legal relations of parties having adverse legal interests; that it be real and substantial and admit of  
 7 specific relief through a decree of a conclusive character, as distinguished from an opinion advising  
 8 what the law would be upon a hypothetical state of facts." *MedImmune*, 127 S. Ct. at 771-72. The  
 9 Supreme Court noted that the Federal Circuit's "reasonable apprehension of imminent suit" test  
 10 conflicted with several cases in which the Supreme Court had found that a declaratory judgment  
 11 plaintiff had a justiciable controversy. *Id.* at 774 n. 11. Although this court mentioned the  
 12 "reasonable apprehension of suit," reliance on that test is neither necessary or required. This court  
 13 determined that KOT had shown by its assertion of a claim under 35 U.S.C. § 256 only that it may  
 14 have a concrete interest in the *outcome* of a determination of the validity or unenforceability rather  
 15 than a definite and concrete dispute. "[E]ven if KOT prevails on its section 256 claim, there is no  
 16 way of knowing that it will continue to challenge the patents' validity and enforceability. . . . Thus,  
 17 the mere fact that it would be convenient for KOT to know whether Besselink could potentially  
 18 become co-inventor of invalid and unenforceable patents does not create an 'actual controversy'  
 19 where otherwise there would be none." April 8, 2005 Order at 23-24. Even under *MedImmune*, the  
 20 court concludes that KOT's previously-dismissed counterclaim for a declaration of invalidity and  
 21 unenforceability does not present an "actual controversy" for this court and denies KOT's motion for  
 22 leave to file a motion for reconsideration.

23  
 24 DATED: 11/5/07  
 25

  
 26 RONALD M. WHYTE  
 27 United States District Judge  
 28

1 **Notice of this document has been electronically sent to:**

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17 registered for e-filing under the court's CM/ECF program.

18 **Dated:** 11/5/07

19 /s/ MAG  
20 **Chambers of Judge Whyte**